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Yasumasa Mizushima

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5171

530

7590

04/20/2006

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EXAMINER

AVELLINO, JOSEPH E

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/008,443

Applicant(s)

MIZUSHIMA ET AL.

Examiner

Joseph E. Avellino

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2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/29/06.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1, 2, and 4-25 are pending in this application.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection on March 13, 2006. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2006 has been entered.

#### ***Information Disclosure Statement***

2. Applicant's IDS dated January 29, 2006 has been considered. See enclosed PTO-1449.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, and 4-25 are rejected under 35 U.S.C. 101 because they do not recite statutory subject matter. With respect to exemplary claim 1, Applicant is advised that in order for a claim to be statutory, it must provide a "useful, concrete, and tangible result". See State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. As such, claim

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1 merely recites data manipulation and execution of various "parts" which, as interpreted by the specification, is computer code. No tangible nor useful result is produced from the invention. Applicant is requested to amend the claims to include language which transmits the actual message and is received by a receiver. The claimed "message transmission part" merely executes "a prescribed piece of transmission processing", not necessarily transmitting the message. Correction is required.

Furthermore claims 23 and 24 recite intangible embodiments of the invention. Claim 23 recites a computer program, which is not tangible. See MPEP 2106 regarding computer programs which must be embodied on a tangible computer medium. Claim 24 is a means-plus-function claim which, as prescribed by 35 USC 112, sixth paragraph, includes the computer program described in ¶ 74 (page 15) and the transmission medium described in ¶ 79 (page 16) of the instant specification. Correction is required.

### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims **1-2, 5, 7-12, 14-19 and 21-25** are rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al. (**US 6,633,630**), hereinafter "Owens".
3. Regarding claim 1,

Owens taught an information processing apparatus for processing a transmission message among a plurality of sites connected via a network, the apparatus comprising: a message reception part that receives a message to execute a prescribed piece of reception processing (**abstract, figs. 1-2 and column 7 lines 22-24**); a rule accumulation part that accumulates a plurality of rules for executing message processing (**abstract, figs. 1-2 and column 7 lines 24-28**); a message conversion part that executes message conversion processing according to the plurality of rules accumulated in the rule accumulation part (**abstract, figs. 1-2, column 7 lines 30-31 and column 10 lines 49-52**); and a message transmission part that executes a prescribed piece of transmission processing of the converted message (**abstract, figs. 1-2 and column 7 lines 28-30**).

Owens further taught, that the receivers are, in fact, plural receivers (column 2 lines 21-27, column 2 lines 2-8, column 5 lines 13-14 and column 10 lines 9-23). Moreover, there is no suggestion in Owens to limit a message to a single receiver, in contrast the e-mails taught by Owens are known in the art of electronic messaging to be send-able to plural recipients with different addresses and different receiving e-mail servers, which is commensurate with plural sites. Applicant should be aware that the statement "wherein the message is used to distribute information among a plurality of traders at the plurality of sites" is merely a statement of intended use and does not apply any limitation to the claimed features of the invention.

Note that Owens disclosed a system for integrating electronic messages in different formats wherein it is inherently disclosed that the receiver of the message will need a client device to access the received messages.

Referencing figure 1, in Owens, it is appreciated that the human user pointed by the applicant is holding a telephone 24 (see column 6 lines 54-59) and it later (column 6 lines 59-65) stated that other interfaces are available. Additionally, see column 1 lines 38-40 and column 2 lines 31-36 in Owens, wherein the disclosure describes the requirement of a device capable of executing a prescribed piece of reception processing.

Owens further taught a message conversion part that executes message conversion and in particular processing according to the plurality of rules accumulated in column 2 lines 44-57 and from column 5 line 59 to column 6 line 13; wherein reformatting and conversion operation to be execute according message receiver's rules are explicitly disclosed. Additionally see column 6 lines 26-33; column 7 lines 24-31, wherein the known preferences are inherently accumulated/stored; and column 10 lines 36-56.

Owens further taught a message transmission part that executes a prescribed piece of transmission processing of the converted message, for example, in column 8

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lines 36-42. Moreover, Applicant admits in page 17 paragraph 1 of the submitted response that Owens "defines forwarding options for the emails..."

Owens further taught the message conversion part converts the message into a prescribed format according to a transmission origin of the message and contents of the message (**column 10 line 65 to column 11 line 3, column 11 lines 51-61**).

4. Regarding claim 8,

Owens taught an information processing method for processing a transmission message among a plurality of sites connected via a network, the method comprising the steps of receiving a message to execute a prescribed piece of reception processing (**abstract, figs. 1-2 and column 7 lines 22-24**); accumulating a plurality of rules for executing pieces of message processing (**abstract, figs. 1-2 and column 7 lines 24-28**); executing message conversion processing according to accumulated by the accumulating step (**abstract, figs. 1 and 2, column 7 lines 30-31 and column 10 lines 49-52**); the plurality of rules and executing a prescribed piece of transmission processing of the converted message (**abstract, figs. 1-2 and column 7 lines 28-30**).

5. Regarding claim 15,

Owens taught a network system comprising: a message reception part that receives a message (**abstract, figs. 1-2 and column 7 lines 22-24**) to execute a prescribed piece of reception a rule accumulation part that accumulates rules for executing pieces of message processing (**abstract, figs. 1-2 and column 7 lines 24-28**); a message

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conversion part that executes message conversion processing according to the plurality of rules accumulated in the rule accumulation part (**abstract, figs. 1-2, column 7 lines 30-31 and column 10 lines 49-52**); and a message transmission part that executes a prescribed piece of transmission processing of the converted message (**abstract, figs. 1-2 and column 7 lines 28-30**).

6. Regarding claims **2, 9 and 16**,

Owens taught a system further a part that starts a corresponding application on the prescribed server to execute message conversion processing when no suitable rules exist in the rule accumulation part (**column 10 lines 62-64**).

7. Regarding claims **4, 11 and 18**,

Owens taught a system; wherein the message conversion part specifies a transmission destination of the message according to a transmission origin of the message and contents of the message (**column 11 lines 56-61**).

8. Regarding claims **5, 12 and 19**,

Owens taught a system wherein the message conversion part performs automatic protocol conversion according to a message transmission destination specified according to a transmission origin of the message and contents of the message (**fig. 9, column 2 lines 52-57, column 10 lines 52-56 and column 13 lines 63-65**).

9. Regarding claim **7, 14 and 21**,

Owens taught a method/apparatus/network system comprising: a message broker that commits to an application processing of data (**abstract, figs. 1-2 and column 7**



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**lines 22-24)** that becomes necessary when message conversion is performed among the plurality of sites (**abstract, figs. 1 and 2, column 7 lines 30-31 and column 10 lines 49-52**); a message translator that performs mutual conversion between message formats according to a prescribed conditional sentence in response to an arrival of a field serving as a trigger in a message format (**abstract, figs. 1 and 2, column 7 lines 30-31, column 10 lines 49-52, column 10 line 65 to column 11 line 3, column 11 lines 51-61**) .; message router that adds a destination address to the message according to a prescribed piece of identification information contained in the message (**column 11 lines 56-61, figs. 1-2 and column 7 lines 28-30**); a B2B connector that provides a message exchange interface between a system and a site outside the system (**column 10 lines 24-61 and figs. 1,6 and 7-9**); and a gateway that provides a local message exchange interface between the system and a local site inside the system (**column 13 line 46 to column 14 line 15 and figs. 1 and 12**).

Owens further taught a B2B connector that provides a messages exchange interface between a system and a site outside the system in the form of forwarding options, in column 10 lines 49-56, wherein Owens clearly exchanges messages between systems. In column 10 lines 49-56, Owens recites:

*"The filtering rules (in accordance with the filtering options selected by the receiver) applied to the message are based on the sender's originating telephone number or e-mail address. The **forwarding** options available are determined by the type of message received from the sender (e.g., voice mail, fax mail or e-mail) and the alternate target device/address (e.g., pager, e-mail account, fax machine, voice mailbox)."*

which is commensurate with providing a message exchange interface.

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Examiner clarifies that the processing of the messages is not performed by a person, but by an automated data processing system as appreciated, for example in figure 3.

Regarding the particular limitations related to a field serving as a trigger in a message format, it is appreciated that in column 8 lines 34-42, Owens describes automatic execution depending on the selected options, commensurate with a trigger. Moreover, Owens utilizes specific triggers, for example in claims 85-89.

**10. Regarding claims 22-25,**

Owens taught a system comprising parts for: receiving a message to execute a prescribed piece of reception processing (**column 7 lines 12-41**); accumulating a plurality of rules for executing the message processing (**column 7 lines 41-50 and column 8 lines 11-42**); executing message conversion processing according to a corresponding one of the plurality of rules accumulated by the rule accumulation step (**column 8 lines 27-42**); and executing a prescribed piece of transmission processing of the converted message (**column 8 lines 36-42**). Owens disclosure is related to networked environments with servers and computers (see **figure 4**), such equipment was well known in the art; and inherently used computer software, recording medium, computer program, computer executable readable medium and apparatuses (see for example **column 20 line 7**).

Claims 10 and 17 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**11.** Claims **6, 13 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (**US 6,633,630**), hereinafter "Owens" in view of Matsuo (**US 5,634,005**) hereinafter "Matsuo".

**12.** Regarding claims **6, 13 and 20**,

Owens taught a system substantially as claimed, however Owens did not expressly teach that the message conversion part executes encryption processing that corresponds to a message to a transmission destination that is specified according transmission origin of the message and contents of the message.

Matsuo, in the same field of invention related to facilitate and automate transmission of electronic mail messages, taught conditionally using encryption for automatic messages processing using rules (**figs. 6-9 and column 9 lines 8-25**).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the methods/systems of Owens with the teachings of Matsuo. Owens motivated the exploration of the art of electronic mail communication (**abstract, figs. 1-3 and column 7 lines 37-41**) and the use of rules to process messages (**column 8 lines 36-42**). The art exploration motivate by Owens is, at least in part, the subject matter of Matsuo (**see title, abstract field of invention and column**

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**1line 40 to column 2 line 15).** The modification would improve Owens system by providing a system that receives a message and determine actions to be performed with the message and the message further transmission including using encryption procedures to send encrypted messages (Matsuo, column 4 lines 50-57) or decrypt a received encrypted message, therefore providing a more secure systems to protect end-users sensitive data.

### ***Response to Arguments***

2. Applicant's arguments filed January 11, 2006 have been fully considered but they are not persuasive.

3. In the remarks, Applicant argues, in substance, that (1) Owens does not analyze the contents of the message, rather determines the formats of the data and the conversion is carried out in response to the determination of such a format.

4. As to point (1), Applicant is incorrect. Applicant is invited to review Owens, particularly col. 11, lines 63-67 where it is stated that "additional rules include *keyword searches on subjects...*". This requires an inherent analysis of the contents of the email, and then converting the inbound email message to a fax machine. Owens clearly shows analyzing the contents of a message, and, based on the contents, of the

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message, converting the message into a prescribed format (i.e. a fax). By this rationale, the rejection is maintained.

### ***Conclusion***

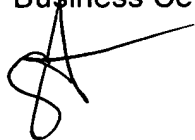
1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

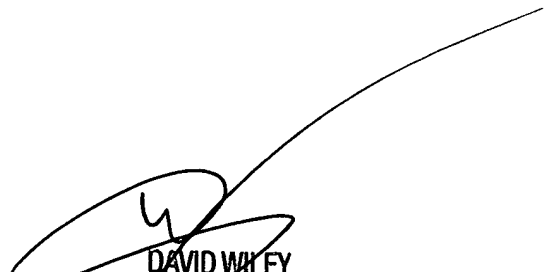
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEA  
April 10, 2006



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100